



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0661-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional):

4541-003/RSW919990088US1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

Date: **February 22, 2006**

Signature:

Typed or printed name: **KATHLEEN KOPPEN**

Application Number:

09/458,922

Filed:

December 10, 1999

First Named Inventor:

Peyravian

Art Unit:

2135

Examiner:

BEEMNET W. DADA

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor

Signature☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

(Form PTO/SB/96)

Stephen A. Herrera☒

attorney or agent of record

Registration Number: 47,642(919) 854-1844

Telephone Number

☐

attorney or agent acting under 37 CFR 1.34.

Registration Number if acting under 37 CFR 1.34 _____

February 22, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ form(s) is/are submitted.

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Peyravian et al.

Serial No.: **09/458,922**

Filed: **December 10, 1999**

For: **Time Stamping Method Employing User
Specified Time**

Docket No: **4541-003**

PATENT PENDING

Examiner: Beemnet W. Dada

Group Art Unit: 2135

Confirmation No.:9481

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☒ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

February 22, 2006
Date


Kathleen Koppen

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants respectfully submit the following remarks in support of the Pre-Appeal Brief Request for Review attached herewith. Claims 1-30 are currently pending. The Examiner has allowed claims 1-12 and 19-30, but has finally rejected claims 13-18 under 35 U.S.C. §102(e) as being anticipated by the patent to Levine (U.S. Patent No. 6,393,566). Anticipation under §102 requires the disclosure of each and every limitation of a claimed invention in a single piece of prior art. Rockwell Intern. Corp. v. U.S., 147 F.3d 1358, 47 U.S.P.Q.2d 1027 (Fed. Cir. 1998). Levine fails to disclosure of each and every limitation of claim 13, and therefore, fails to anticipate any of claims 13-18 under §102.

Claim 13, the sole rejected independent claim, is directed to a computer-implemented method for time stamping a digital document calls. Claim 13 recites, "creating a time stamp receipt including identifying data associated with said document and a time indication ... [and] ... transmitting said time stamp receipt to an outside agency." In other words, the time stamp

receipt transmitted to the outside agency already includes both the identifying data (e.g., a hash of a document) and a time indication. For reference, claim 13 appears below in its entirety.

13. A computer-implemented method for time stamping a document comprising:
creating a time stamp receipt including identifying data associated with said document and a time indication;
transmitting said time stamp receipt to an outside agency; and
cryptographically binding at said outside agency said identifying data and said time indication.

Levine does not disclose transmitting a time stamp receipt that includes both identifying data and a time indication to an outside agency. In contrast, Levine discloses an authenticating agency that adds a time stamp to the document after the agency receives the document. The Levine patent undergirds this fact.

The authenticating agency in Levine includes two computers – a “front” or “public” machine and a “back” or “private” machine. The authenticating agency receives time-stamp requests via the public machine, which is connected to the Internet. The requests include data associated with a document to be time-stamped and signed by the authenticating agency. The private machine then downloads the data associated with the request from the public machine over a secure link, applies a digital signature to the data, and returns the signed message to the public machine for transmission to the requesting party. *Levine*, col. 3, ln. 31 – col. 4, ln. 8.

It is inescapable that the authenticating agency in Levine adds a time stamp to the data after the agency receives the data from the requesting party.

The time of the “front” computer is continuously available to any user on the Internet in a number of standard formats including NTP. Any user may request the time in any standard format as often as desired and can compare that time with UTC time information to verify the accuracy of the time-stamping performed by the front machine.

Levine, col. 3, ll. 47-53 (emphasis added).

FIG. 2 shows the server process carried out on the public machine 10 upon reception of input mail. This process is started by the operating system of the public machine whenever a message is received for time-stamping. ...When the

end of the message text is received a time-stamp is added at step 22 and stored with the text.

Levine, col. 6, ll. 9-19 (emphasis added); *see also*, col. 5, ll. 39-65. These passages make clear that whatever data is transmitted to the authenticating agency does not include a time indication. The time indication is added by the authenticating agency, and therefore necessarily cannot occur until after the document is transmitted to the authenticating agency.

Even the Examiner supports this fact. “[The] Examiner would point out that Levine teaches creating the hash code of the message and the time stamp in the private machine.” *Advisory Action*, p. 2, ll. 3-4 (emphasis added). The private machine referred to by the Examiner is, as stated above, part of the authenticating agency. Thus, if the private machine creates the time stamp as the Examiner admits, the authenticating agency must have already received the document at the public machine and the private machine without a time stamp.

Nevertheless, the Examiner stated basis for the rejection is that the authenticating agency does not require the public machine. Rather, the public machine could be any computing device connected to the Internet that time stamps a document prior to sending it to the private machine of the agency.¹ However, *Levine* does not support such an assertion.

Levine specifically employs the public machine to isolate the private machine from malicious attacks and other access by the general public. *Levine*, col. 7, ln. 57 – col. 8, ln. 9. *Levine* even discloses a private protocol between the public and private machines to ensure this isolation. *Levine*, col. 5, ll. 47-56; Figure 1. Further, Levin praises the advantages of this two-machine method.

Another advantage of the system is that a message which is submitted to the public machine by E-mail will have time-stamps and routing information added to it so that the message that is actually signed will differ from that which was submitted by the sender. The time-stamp and the routing information added to the message as it travels the Internet system are unpredictable from the point of view of the submitter. In that fashion, the message to be signed cannot be

¹ The Examiner stated this contention during the telephonic interview conducted December 20, 2005. See Applicants' Response to Final Office Action dated December 21, 2005, pg. 2 ¶2.

completely specified by the submitter which may help to foil certain types of attacks against the procedure.

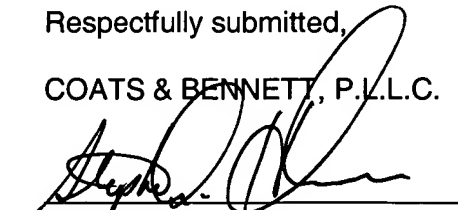
Levine, col. 8, ll. 10-19 (emphasis added). *Levine* simply does not support the Examiner's assertion. *Levine* clearly discloses that time stamps transmitted to the authenticating agency are unpredictable and cannot be trusted. Thus, *Levine* necessarily requires the public machine to be located at the authenticating agency for the method to operate as disclosed. Removing the public machine from the realm of the authenticating agency as proposed by the Examiner would render *Levine* unusable for its intended purpose.

Levine plainly situates both the public machine and the private machine within the realm of the authenticating agency. One skilled in the art armed with the *Levine* patent would understand this to be true. Whatever information is transmitted between these machines is therefore transmitted within the authenticating agency, and thus, cannot be transmitted to the authenticating agency. *Levine* does not disclose, "transmitting said time stamp receipt [that includes a time indication] to an outside agency" as recited by claim 13. Accordingly, the §102 rejection of claim 13 and its dependent claims 14-18 fail as a matter of law.

For at least the foregoing reasons, the §102 rejections fail as a matter of law. As such, Applicants request the withdrawal of the §102 rejections, and the allowance of all pending claims.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.



Stephen A. Herrera
Registration No.: 47,642

Dated: February 22, 2006

P.O. Box 5
Raleigh, NC 27602
Telephone: (919) 854-1844
Facsimile: (919) 854-2084